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19 FEB 1997

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In re Application of
TAYLOR
Application No.: 08/604,975
PCT No.: PCT/GB94/00995
Int. Filing Date: 09 May 1994
Priority Date: 25 September 1993
Attorney Docket No.: ITI-169
For: IMPROVEMENTS RELATING TO THE
LINING OF PIPELINES OR
PASSAGEWAYS

DECISION ON PETITION

This is a decision on the "RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.47(b)..." filed in the Patent and Trademark Office (PTO) on 13 December 1996, and on the first, second, and third supplemental submissions in support of the renewed petition which were filed in the PTO on 10 January 1997, 21 January 1997, and 29 January 1997, respectively.

BACKGROUND

On 25 March 1996, a transmittal letter for entry into the national stage in the United States was filed which was accompanied by, inter alia, an initial petition urging that the application be accepted as filed by the assignee on behalf of the inventor, Mr. Kevan Taylor, under 37 CFR 1.47(b) on the grounds that the inventor cannot be located.

On 12 July 1996, a decision was mailed which dismissed the petition on the grounds that the 37 CFR 1.47(b) had failed to provide acceptable factual proof that the inventor could not be reached after diligent effort, an acceptable statement of the last known address of the inventor, and acceptable proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application. The decision set a two month period for response.

On 13 December 1996, applicant filed the present renewed petition which was accompanied by, inter alia: a declarations of Raymond P. Toth, John W. Heavens, Michael I. Wolfson, Andrew M. Donlan, and Regan L. Trumper in support of the renewed petition; a copy of an employment agreement between Mr. Taylor and Instituform Technical Services Limited; and a petition and fee for a three-month extension of time.

On 10 January 1997, applicant filed a first supplemental submission which was accompanied by, inter alia, a supplemental declaration of Michael I. Wolfson in support of the renewed petition.

On 21 January 1997, applicant filed a second supplemental submission which was accompanied by, inter alia, another supplemental declaration of Michael I. Wolfson in support of the renewed petition.

On 29 January 1997, applicant filed a third supplemental submission which was accompanied by, inter alia, a third supplemental declaration of Michael I. Wolfson in support of the renewed petition.

DISCUSSION

First it should be noted that the period for response as extended by the petition and fee for a three-month extension of time expired on 12 December 1996. In that the present renewed petition was deposited by "Express Mail" on 13 December 1996, the additional fee of \$540 (fee code 118) for the additional one-month extension in order to accept the renewed petition as having been timely filed has been charged to counsel's Deposit Account No. 03-3415 as authorized in the petition.

As set forth in the prior decision, a petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Items (1), (4), and (6) have been satisfied.

Concerning item (2) above, in view of the statements made in the third supplemental submission, the 37 CFR 1.47(b) applicant is apparently no longer contending that Mr. Taylor cannot be located, but rather the submission now states "Mr. Taylor acknowledged receipt of my letter requesting that he sign the Declaration...[but] he has not done so." As such the petition is hereby being treated as requesting acceptance of the application on the grounds that the inventor refuses to sign. In this regard section 409.03(d) Manual of Patent Examining Procedure (MPEP) states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the application reveals that the 37 CFR 1.47(b) applicant has not provided any such statement establishing that Mr. Taylor refuses to sign the application papers. Further, it has not been established that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, only that Mr. Taylor has been presented with a copy of the declaration and assignment papers. Therefore, item (2) cannot be said to have been satisfied.

Item (3) above also cannot be said to have been satisfied at this time in that the most recent statement of Mr. Taylor's last known address is in the first supplemental submission in which Mr. Taylor's address is set forth as League City, Texas. However, it appears from the third supplemental submission that this is no longer Mr. Taylor's most

recent address. As such, a new statement positively setting forth Mr. Taylor's last known address is required.

Concerning item (5), the 37 CFR 1.47(b) applicant has not provided sufficient proof that it has sufficient proprietary interest in the invention. As stated in the prior decision, a review of the application file reveals that the 37 CFR 1.47(b) applicant is apparently relying on such an employment agreement to establish its proprietary interest. The prior decision set forth that the 37 CFR 1.47(b) applicant had not established "firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant." In this regard, applicant has submitted a statement from Mr. John Heavens establishing his firsthand knowledge of the facts as they pertain to Mr. Taylor's employment and invention of the subject matter of the present application. Mr. Heaven's statement sets forth that "the subject matter of the application was completed by the Spring, 1993." However, it is noted that the employment agreement that the 37 CFR 1.47(b) applicant is relying upon was not entered into until 19 July 1993, and was apparently not effective until 01 August 1993. Therefore, since the invention of the subject matter apparently took place prior to the effective date of the employment agreement being relied upon, it cannot be accepted as establishing the proprietary interest of the 37 CFR 1.47(b) applicant. A review of the application file reveals that at the time of the invention, the inventor was apparently an employee of Instituform Technical Services Limited, and a review of the employment agreement between Mr. Taylor and Instituform Technical Services Limited reveals that it contains no such language regarding the assignment of inventions made during Mr. Taylor's employment. A review of the application file reveals that the 37 CFR 1.47(b) applicant is apparently also relying upon British law to establish proprietary interest during this period. In this regard, section 409.03(f) of the MPEP states, in part:

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Therefore, in that such a legal memorandum has not been submitted, item (5) also has not been satisfied. It should be noted that, in addition to the submission of such a legal memorandum, the 37 CFR 1.47(b) applicant must also clearly establish its ownership of Institutum Technical Services Limited.

In that items (2), (3), and (5) above have not been satisfied, granting of the petition at this time would again not be appropriate.

CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

A proper response must include an acceptable showing that the inventor refuses to sign, a clarification of Mr. Taylor's last known address, and an acceptable showing of sufficient proprietary interest as discussed above, or in the alternative, a declaration in compliance with 37 CFR 1.497 executed by Mr. Taylor.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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